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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,152	06/12/2000	Ryoichi Imanaka	MAT-3720US1	8730

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EXAMINER
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PARRY, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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2421

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/594,152	<b>Applicant(s)</b> IMANAKA, RYOICHI	
	<b>Examiner</b> CHRIS PARRY	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,4,7-13,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3,4 and 7-11 is/are allowed.
- 6) ☒ Claim(s) 12,13,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Reissue Applications***

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,790,172 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 12 and 13 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 12 recites the limitation "the information" in line 5. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 12 recites the limitation "said request" in line 13. There is insufficient antecedent basis for this limitation in the claim.

It is unclear as to whether "said request" refers to "a first request" in line 3 or to "a second request" in line 4. For the purposes of examination, "said request" will be interpreted as referring to "a second request".

7. Claim 13 recites the limitation "said request" in line 12. There is insufficient antecedent basis for this limitation in the claim.

It is unclear as to whether "said request" refers to "a first request" in line 3 or to "a second request" in line 4. For the purposes of examination, "said request" will be interpreted as referring to "a second request".

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12, 13, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito (USPN 5,901,339) in view of Durden et al. "Durden" (USPN 5,003,384) and further in view of Horton et al. "Horton" (USPN 4,945,563).

Regarding Claim 12, Saito discloses a method for providing a program having a title on demand (Col. 7, lines 29-45) comprising the steps of:

receiving a first request requesting said program having said title (i.e., applicant for viewing a broadcast program sends a viewing request such that the receiving device outputs the program to a TV) (Col. 7, lines 31-34 and Col. 4, lines 30-32 and 37-42);

receiving a second request requesting said program having said title (i.e., applicant for viewing a broadcast program sends a viewing request such that the receiving device outputs the program to a VTR) (Col. 7, lines 31-34 and Col. 4, lines 30-32 and 37-42);

transmitting the information to a subscriber display means (i.e., TV in fig. 2) for displaying said program having said title without causing recording of said program having said title responsive to said first request (i.e., the received desired broadcasting program is displayed on the subscriber's TV) (Col. 7, lines 39-40 and Col. 4, lines 35-42), and

transmitting said program having said title to a subscriber recording means (i.e., VTR in fig. 2) for recording said program having said title responsive to said second request (i.e., the received desired broadcasting program is recorded by the subscriber's VTR) (Col. 7, lines 39-40 and Col. 4, lines 35-42), and

charging the subscriber a fee to display the program (i.e., the charging center receives the request and collects a fee for the program) (Col. 7, lines 35-38 and Col. 4, lines 30-35).

Saito fails to disclose wherein said [second] request for said program having said title indicates whether the subscriber is recording said program having said title on said recording means.

In an analogous art, Durden discloses wherein said request (i.e., "Pre-Buy) for said program having said title indicates whether the subscriber is recording said program having said title on said recording means (i.e., a subscriber has the ability to pre-buy a PPV event wherein a pre-buy allows the subscriber to record the PPV event and the record of the pre-buy or "subscriber request" is transmitted to system manager 8) (fig. 3; Col. 11, line 57 to Col. 12, line 14 and Col. 12, lines 24-32 and 56-66).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Saito to include wherein said request for said program having said title indicates whether the subscriber is recording said program having said title on said recording means as taught by Durden for the benefit of increasing control and enhancing the diversity of an impulse pay-per-view system.

Saito and Durden disclose, in particular Saito teaches a charging center for charging the user a fee for the purchase of an on-demand program. However, the combination of Saito and Durden fail to disclose or suggest charging different amounts depending upon whether the transmitted program having said title is a) displayed

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without being recorded responsive to the first request or b) recorded responsive to the second request.

In an analogous art, Horton discloses a viewer may request a program, such as a first run movie, and depending upon a selected viewing mode, the selected program may be viewed and the viewer would pay a first fee or the viewer could choose to view and record the program for a second higher fee (Col. 2, lines 56-65 and Col. 3, lines 39-53). Horton teaches it is well known in the art for a cable or satellite provider to charge a viewer different amounts depending upon whether the viewer has selected to merely view the program or has selected to create a copy of the program by recording it for later or repeated viewing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Saito and Durden to include charging different amounts depending upon whether the transmitted program having said title is a) displayed without being recorded responsive to the first request or b) recorded responsive to the second request as taught by Horton for the benefit of combining prior art elements according to known methods to yield predictable results of charging a second higher fee that includes a charge related to the purchase of a cassette of the program while preventing the viewer from making pirated copies of the recorded program (Horton: Col. 2, line 63 to Col. 3, line 3).

Regarding Claim 13, Saito discloses an apparatus (i.e., charging center and TV program broadcasting station – figs. 2 and 5) for providing a program having a title on demand (Col. 7, lines 29-45) comprising:

receiving means (i.e., public telephone line receiver on charging center) for receiving a first request for said program having said title (i.e., applicant for viewing a broadcast program sends a viewing request such that the receiving device outputs the program to a TV) and a second request for said program having said title (i.e., applicant for viewing a broadcast program sends a viewing request such that the receiving device outputs the program to a VTR) (Col. 7, lines 31-34 and Col. 4, lines 30-32 and 37-42);

sending means (i.e., TV program broadcasting station) for sending said program having said title to a subscriber display means (i.e., TV in fig. 2) without causing recording of said program having said title responsive to said first request (i.e., the received desired broadcasting program is displayed on the subscriber's TV) and sending said program having said title to a subscriber recording means (i.e., VTR in fig. 2) for recording said program having said title (i.e., the received desired broadcasting program is recorded by the subscriber's VTR) (Col. 7, lines 39-40 and Col. 4, lines 35-42), and

charging means (i.e., charging center) for charging the subscriber a fee to display the requested program (i.e., the charging center receives the request and collects a fee for the program) (Col. 7, lines 35-38 and Col. 4, lines 30-35).

Saito fails to disclose wherein said [second] request for said program having said title indicates whether the subscriber is recording said program having said title on said recording means.

In an analogous art, Durden discloses wherein said request (i.e., "Pre-Buy") for said program having said title indicates whether said program having said title is being



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recorded on said recording means (i.e., a subscriber has the ability to pre-buy a PPV event wherein a pre-buy allows the subscriber to record the PPV event and the record of the pre-buy or "subscriber request" is transmitted to system manager 8) (fig. 3; Col. 11, line 57 to Col. 12, line 14 and Col. 12, lines 24-32 and 56-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Saito to include wherein said request for said program having said title indicates whether said program having said title is being recorded on said recording means as taught by Durden for the benefit of increasing control and enhancing the diversity of an impulse pay-per-view system.

Saito and Durden disclose, in particular Saito teaches a charging center or "charging means" for charging the user a fee for the purchase of an on-demand program. However, the combination of Saito and Durden fail to disclose or suggest charging different amounts depending upon whether the transmitted program having said title is a) displayed without being recorded responsive to the first request or b) recorded responsive to the second request.

In an analogous art, Horton discloses a viewer may request a program, such as a first run movie, and depending upon a selected viewing mode, the selected program may be viewed and the viewer would pay a first fee or the viewer could choose to view and record the program for a second higher fee (Col. 2, lines 56-65 and Col. 3, lines 39-53). Horton teaches it is well known in the art for a cable or satellite provider to charge a viewer different amounts depending upon whether the viewer has selected to merely view the program or has selected to create a copy of the program by recording it for

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later or repeated viewing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Saito and Durden to include charging different amounts depending upon whether the transmitted program having said title is a) displayed without being recorded responsive to the first request or b) recorded responsive to the second request as taught by Horton for the benefit of combining prior art elements according to known methods to yield predictable results of charging a second higher fee that includes a charge related to the purchase of a cassette of the program while preventing the viewer from making pirated copies of the recorded program (Horton: Col. 2, line 63 to Col. 3, line 3).

As for Claim 21, Saito, Durden, and Horton disclose, in particular Horton teaches wherein said program is other than a shortened version of said program which is displayed for a lower charged amount than said program being displayed without being shortened (i.e., depending upon a selected viewing mode, the selected program may be viewed and the viewer would pay a first lower fee or the viewer could choose to view and record the program for a second higher fee) (Col. 2, lines 56-65 and Col. 3, lines 39-53).

As for Claim 22, Saito, Durden, and Horton disclose, in particular Horton teaches wherein said program is other than a shortened version of said program which is displayed for a lower charged amount than said program being displayed without being shortened (i.e., depending upon a selected viewing mode, the selected program may be

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viewed and the viewer would pay a first lower fee or the viewer could choose to view and record the program for a second higher fee) (Col. 2, lines 56-65 and Col. 3, lines 39-53).

***Allowable Subject Matter***

10. Claims 3, 4, and 7-10 are allowed.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS PARRY whose telephone number is (571) 272-8328. The examiner can normally be reached on Monday through Friday, 8:00 AM EST to 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN MILLER can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/  
Supervisory Patent Examiner, Art Unit 2421

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